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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,809	07/18/2000	Robert Brookes	1520A1	8005

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EXAMINER

SHAFFER, ERIC T

ART UNIT PAPER NUMBER

3623

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/618,809

Applicant(s)

BROOKES ET AL.

Examiner

Eric T. Shaffer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47 - 52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47 - 52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to the amendments filed October 23, 2003.

Summary of Instant Office Action

2. Applicant's arguments, filed October 23, 2003, concerning claims 1 – 52 in the Office Action mailed May 8, 2003, have been considered, deemed unpersuasive and are maintained.

Claims 1 - 46 have been cancelled. Newly added claims 47 – 52 have been entered.

Now, claims 47 - 52 are pending and are prosecuted in the response sent out below.

Claim Rejections - 35 USC § 101

3. Claims 47 – 52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e. abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, invoke, use, or advance the technological arts.

In the present case, the method of coordinating services does not specifically use technology to carry out any of the non-trivial claimed method steps. For example, the steps of claim 1 of providing a database of service providers, obtaining service needs, generating a list of service providers and ranking service providers may be performed manually or without the aid of any technology. Thus, claims 47 - 52 do not affect, effect, or are affected by technology, and thus do not recite statutory subject matter. Use of a computer, a computer operable medium, or some other technology device is required for said claims to be patentable.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 47 – 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegrist, Jr. (US 5,652,842).

As per claims 47 and 48, Siegrist, Jr et al teaches a method of coordinating services, comprising the steps of:

providing a database of service providers, the database including location (figure 12b, “zip code, town, community”) and pricing information (columns 89 – 94, table VI) relating to each service provider, pricing criteria of the organization, and supplemental inducements offered by individual service providers (column 3, lines 40 – 45, “hospital cost information is usually

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acquired from the HCA in the form of a Medicare Cost Report, which includes cost and charge information for the twenty-five departments in every hospital”);

obtaining service need information concerning a customer of the paying organization (column 3, lines 37 – 41, “patient level information, which includes demographic, clinical and charge data in forty-two categories”), including location of the service need (figure 12a, “Patient Summary: Hospital”);

generating a preliminary list of service providers selected from the paying organization, including location of the service need (column 4, lines 3 – 9, “the parameters input by the user determine, for example, which patient groups to compare in which hospitals and, therefore, which of the patient level cost and charge information to retrieve from the database. Once the appropriate information has been retrieved, the information is accumulated to create total cost and charge information for the chosen patient groups in the chosen hospitals”);

generating a final list of service providers as a subset of the preliminary list, comprising a plurality of service providers having the most favorable supplemental inducements (columns 93 – 94, Table VII), where supplemental inducements are the specialty services provided by the service provider;

presenting in order of ranking, at least one of the ranked service providers to the customer for choice to perform the service (figure 10).

Siegrist Jr et al does not specifically teach a ranking of the selected service providers employing the criteria of including the time interval since the last service performed by each service provider, identifying the last date on which the service providers were assigned a service

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job when the customer has no repair shop preference, and then ranking the service providers by the last service job date, with the most recent service ranked last.

However Siegrist Jr et al does teach ranking service providers by price, by variance from an average industry price, by type of insurance, by average patient age and by length of stay (column 98, table XI). Since the length of a patient stay is a measure of the time since an operation service was performed, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the age field (column 9, line 10, "age"), as a measure of the last time an operation or service was performed in order to identify and compare medical service providers. A timeliness measure of how recent the service providers experience and expertise in a given procedure would be valuable to customers looking for a service provider with the most recent, state of the art equipment and skills. Many customers would be willing to pay a premium price for such cutting edge skills and would find this criteria to be just as important as price in selecting a service provider. Similarly, finding the service provider with the oldest date for having provided the service would be useful for a customer looking for the service provider with the most amount of experience performing a specific service, and this too would be as important as price to a customer looking for a premium service.

6. As per claim 49, while Siegrist, Jr et al does not specifically discloses a method including billing the organization a fixed fee for each service coordinated transaction, official notice is taken that charging a fee to use a service is old and very well known in the art of business methods. Charging a fixed fee to use a service is an essential element to generating revenue and making an entrepreneurial endeavor profitable. Unless a service provider charged a fee, most commonly referred to as a service fee, said service provider would not be able to generate

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sufficient revenue to continue in operation as a going concern. It would be obvious to collect a fee to at the very least to cover the operating expenses and keep the business in business.

7. As per claim 50, Siegrist, Jr et al teaches a method wherein the organization is at least one insurance company and the customer is a policyholder of said at least one insurance company(column 97, lines 38 – 45, “Medicare, Blue Cross, HMO, Medicaid”).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegrist Jr. et al (US 5,652,842) in view of Borghesi et al (US 5,950,169).

Siegrist Jr. et al teaches an invention features a computer-based method of aiding comparison of competitive performance of a plurality of service providers by price, length of stay time required to complete the service, by age of customer, and by type of customer insurance. The Siegrist Jr. et al invention teaches an application specific to the health care service provider industry and does not specifically relate to the automotive repair industry.

10. Borghesi et al teaches a system for processing automobile insurance repair claims (column 2, lines 50 - 54, “the data file contains data on the insured, including policy information; data on a claim, such as the extent of damage or injury; and data on satisfying a claim including repair estimates and total loss valuation of, for example, an automobile”).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the price and amenity shopping aspects of the Siegrist Jr. invention with the Borghesi insurance claim processing functionality in order to create a device that would allow an insurance claim process to incorporate more than one price quote from several service providers because this would enable the insurance company to obtain the lowest competitive bid, thereby saving the insurance company money by obtaining a comparable service for a lower price.

Response to Amendments

11. Applicant's arguments filed on October 23, 2003 have been fully considered, but the same are not persuasive.

Applicant argues that neither Siegrist nor Borghesi teach the use of unique competitive offers such as extra discounts or free add-ons. However such offers are not specifically claimed in the applicant's claim language, the applicant merely makes a vague mention of supplemental inducements.

Applicant argues that Siegrist is an after-the-fact information gathering and evaluation of service providers and does not coordinate a market by matching service needs with service providers. However the applicant's invention does not match needs per se, it merely selects and sorts a list of suggested service providers based on the input criteria of the user. Siegrist does teach an invention that takes marketing information and generates a list of service providers based on the users desire to sort by the specific criteria of price, length of stay time required to complete the service, by age of customer, and by type of customer insurance.

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Applicant argues that Borghesi barely mentions the process of matching a repair need. However Borghesi does mention matching a repair need with a particular repair shop.

Applicant argues that Borghesi does not mention selection of a repair shop. However the applicant's claim language does not actually mention selecting a repair shop, and only mentions listing a final list of service providers.

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Conclusion

24. THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of final action.

25. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric Shaffer whose telephone number is (703) 305-5283. The Examiner can normally be reached on Monday-Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax number for the organization is (703) 305-0040/308-6306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 305-3900.

Eric Shaffer

December 30, 2003

Romain Jeanty
Primary Examiner
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